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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,373	09/30/2003	Stefan Jesse	09700.0216-00	3224

60668 7590 09/20/2011

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EXAMINER	
VU, TUAN A	

ART UNIT	PAPER NUMBER
2193	

MAIL DATE	DELIVERY MODE
09/20/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/676,373	**Applicant(s)** JESSE ET AL.
	Examiner TUAN VU	**Art Unit** 2193

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 September 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires *3* months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1,3,4,6-10,12,14-18 and 20-26*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☒ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Tuan A Vu/
Primary Examiner, Art Unit 2193

Continuation of 11. does NOT place the application in condition for allowance because:
In response to the explanation that para 0030 and 0074 of the Disclosure clearly teach 'deriving a API' it is noted in these paragraphs that the combination of UML and its XML/DOM representation, (via XMI or SAX)enable generation of java objects, and these are inputs to generation of code that is included in metadata API 130. As the claim language recites 'generate code … to derive an API enabling … tools to access development objects' it is not clear whether the code generated from derived java intermediate objects is the API or the encompassing metadata API 130 is the "API". Further, one cannot see clearly how code included in metadata 130 as disclosed teaches 'enabling development tools' to access other objects; nor can one see exactly where metadata API 130 is actually derived from using the generated code. One must make a clear distinction between (i) including code inside a tool to help generate other APIs thereby enabling access of development objects, and (2) using the generated code (taking java objects as inputs, the java objects derived from SAX or XMI) to derive a metadata 130. None of (1) and (2) is clearly equivalent or interchangeable based on the claim language regarding 'deriving an API' (is it the same API as in the preamble stating a metadata API) with comparison to Applicant's providing of para 0030 or 0074. One the one hand, as proferred in para 0030, code (generated in (2)) included in a metadata API -- being a environment that can yield other XML schema -- does not constitute the fact that metadata 130 is actually a direct derivation of that code. On the other hand, if deriving a API amounts to generating code using inputs like Java objects, this code would not be consistent with 'deriving a metadata API' in the preamble, because nowhere in the Disclosure support s the fact that this 'generated code' again serve to derive any low level API, in a sense that this low level API is different from the encompassing API 130. The only possible interpretation is that the derived API as claimed MUST be metadata API 130, which serves as a functional structure from which to derive more proxies or XML, the API 130 (para 0030) this API 130 not directly a derivation from the generated code but rather used as a tool provider or a container for said generated code (using Java inputs) to derive proxies, state classes or marshalling code or XML. In short, the metadata API being a development container to generate more proxies, or marshalling code cannot be viewed as a result from deriving anything from the generated code (using Java objects as input) since the Disclosure clearly state that the generated code is included in this API 130. The disclosure goes on to state that one result of API derivation is a XML schema; and this has nothing to do with using Java objects as inputs to yield code that actually help derive the API 130 as construed from the claim language. The amended claim is largely inconsistent with regard to a same reciting of "deriving of API" (preamble and end of claim) inside the claim and with the explicit teaching from para 0030. The amended claim cannot be entered for fear that it will complicate effect of an Appeal Brief. More importantly, the lack of support for the feature such as "API" being derived from 'generate code' (using set of intermediate objects as inputs) remains an unresolved issue, in view of the above.
In reply to the argument that the Examiner has introduced invented words or definition apparentlby in view of the repugnancy of the original wording is construed as a offside remarks that cannot constitute facts showing how the language exactly as claimed would not be met by a combination of teachings as demonstrated in the Office rationale. It is also reminded that the language of 'deriving an API' remains a sustained deficiency otherwise viewed as a language aberrancy without proper corroborative explanation from the entire Disclosure, in spite of the effort by Applicant in put forth para 0030, 0074.
In response to the argument that Worden is not mentioned in the rationale statement of obviousness, it is noted that non-obviousness of a particular feature cannot be judged solely by the fact that name of a reference is absent in a 103 statement of obviounsess, when in fact the term 'DOM' (taught by Worden) is among the teachings leading to that very 'it would be obvious' statement.
In reply that none of the reference teaches 'using intermediate objects as inputs to derive … API' , it is noted that the intermediate objects are taught (see pg. 30 of Specifications of record) as supporting generation of code 'included in the metadata API 130'; i.e. they don't serve as deriving that API, as this has been analyzed at length from above.
In reply to the assertion that Severin does not teach 'deriving a API' thereby fails to remedy to Kadel, the Office action has presented a combination of teachings; and attacking piecemeal one reference at a time cannot be sufficient to show non-obviousness, necessarily when the very claimed language at stakes amounts to a lack of corroborative teaching from the entire disclosure. That is, the metadata API 130 includes code generated (*) from java intermediate objects, and as such, only serves as developmnet container/tool for more proxies, marshalling code or other XML to be generated; and this container is not remotely a product directly from deriving anything from said generated code (see *) because the generated code are merely taught as being included in the API 130. To alleviate complications of a potential Appeal, the changes to the claim will not be entered.